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10/057,305	01/23/2002	Hoon Bum Lee	B-4475 619477-6	1950

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT

PAPER NUMBER

3731

10

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,305

Applicant(s)

LEE, HOON BUM

Examiner

Bradford C Pantuck

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 20, 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-15, and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 23, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/27/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I: claims 1-6, 10-15, and 18-20 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that there is not a burden to search the multiple species. This is not found persuasive because it would take considerable time to search the various embodiments, including different shapes of cutting members, and the different mechanisms for moving the cutting members.

The requirement is still deemed proper and is therefore made FINAL. Claims 7-9, 16, and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration. *The declaration must have both the residence and the mailing address of the inventor.*

It does not identify the citizenship of each inventor.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).
Correction of the following is required: the term “magnetically operated *plunger* type” (or similar language) is not found in the specification. There is no such plunger described in the specification.
4. The amendment filed February 20, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 14 claims a “magnetically operated *plunger* type”. However, Examiner cannot locate any reference to a magnetic plunger component of the invention.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

5. Claim 4 is objected to because of the following informalities: change “an” to “a” in line 3 of the claim. Appropriate correction is required. Also, switch the positioning of the word “the” in line 6 with the word “approximately” of line 7.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-6, 10-15, and 18-20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the several instances that Applicant uses "surface ("imaginary surface")", the claim is unclear. Is applicant referring to the *actual* surface of the blade or the so-called "imaginary surface" of the blade? Applicant does not explain the concept of an "imaginary surface" very clearly, and so it is unclear to which surface Applicant is referring.
7. Also, regarding Claim 2, the phrase, "inclines towards the side of the cylindrically shaped first member," is indefinite because it is unclear to which side, in particular, Applicant is referring. Cylinders have an inner surface and an outer surface.
8. Claim 6 recites the limitation "the conical front part of the housing" in line 2. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 14 recites the limitation "the power transmitting member" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5, 10-13, 15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,251,641 to Xavier in view of U.S. Patent No.

5,961,534 to Banik et al. Regarding Claim 1, Xavier discloses a biopsy device having a first cutting member (12) [Fig. 7] and a second cutting member (28) [Fig. 8].

Although Xavier's device is not meant to perform a hair-transplanting procedure, his device matches the structure of Applicant's invention and is thus capable of such a surgery. The device is intended to cut through tissue fairly atraumatically and remove it from the body [Column 1, lines 18-23]. As shown in Figure 7, Xavier's first cutting member (12) has an elongate and hollow shape [Column 2, lines 20-28]. This cutting member (12) has a blade (20/22/26) at its front end [see Fig. 4 especially; Column 2, lines 28-35]. This sharpened distal part of component (12) is certainly capable of piercing the skin of the scalp. This blade (especially 26) inclines towards one side, as is evident from Figure 4.

As is shown in Figure 3, Xavier's second cutting member (28) has an elongate and hollow shape, and can move forwards and backwards [Column 2, lines 41-49]. It has a blade (36/38/42) at its distal end. The blade of the first cutting member (12) meets and faces the blade of the second cutting member (28) when they are adjacent to each other [see Fig. 6; Column 3, lines 14-21].

Xavier's assembly includes a housing (44/46) [Column 2, lines 50-59]. His assembly does not include an extrusion member to push a hair graft out of the cannula, and he says merely that the tissue can be removed from the device [Column 4, lines 36-44]. However, Banik discloses another biopsy device with a rotating cutter at its front end. Banik teaches that one ought to have a central extrusion member (25) for removing the biopsy samples collected in the central storage space

[Column 3, lines 37-41; Figure 2]. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include an extrusion member with the device of Xavier in order to push the collected biopsy sample out of the holding chamber for inspection by the medical personnel, as taught by Banik.

11. Regarding Claim 2, Xavier discloses a first cutting member (12) with a blade surface having an semi-elliptical shape [see Fig. 7]. Particularly cutting component (26) has a semi-elliptical shape. The second cutting member (28) has a face of its own blade (as all blades do), which is approximately opposite to the face of the first cutting member's face.
12. Regarding Claim 3, the axis of the blade surface (26) of the first cutting member (12) inclines a little bit (slightly) [see Fig. 4].
13. Regarding Claim 4, as the two members revolve with respect to each other, the opening at the front end of the device becomes closed, as shown in Figure 6 and described in Column 3, lines 22-30.
14. Regarding Claim 5, Banik's extruding member is made from a flexible material and its end protrudes from the first cutting member [Banik: Fig. 2]. In Figure 2 the extruding member is shown moving forward, and the extruding member can be pushed further up to extend out of the hole (29) [Banik: Column 4, lines 30-33]. The extruding member would be arranged in a similar fashion in the modified Xavier device.
15. Regarding Claims 10 and 11, Xavier's device is intended to perform a biopsy of body tissue [Column 1, lines 6 and 7].

16. Regarding Claims 12 and 13, Xavier's cutting member (28) meets all the respective limitations of the "first cutting member" and the "second cutting member" as claimed in claim 1. Xavier's cutting member (12) also meets all the respective limitations of the "first cutting member" and the "second cutting member" as claimed in claim 1.
17. Regarding Claim 15, an operating handle (46) is attached to the cutting members in such a way that turning it will cause the cutting members to move in opposite directions [Column 2, lines 50-54].
18. Regarding Claims 18 and 19, Xavier's Figure 6 shows opposing blades, facing each other, with surfaces rotated 180 degrees with respect to each other.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,142,957 to Diamond et al.

U.S. Patent No. 5,292,310 to Yoon

U.S. Patent No. 4,799,494 to Wang

U.S. Patent No. 4,708,147 to Haaga

U.S. Patent No. 6,162,203 to Haaga

U.S. Patent No. 6,248,081 B1 to Nishtalas et al.

U.S. Patent No. 6,641,564 B1 to Kraus


U.S. Patent No. 5,741,287 to Alden et al.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Milano
Supervisory Patent Examiner
Art Unit 3731


BCP

March 17, 2004